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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/621,360   | 07/18/2003  | Kazuaki Yoshida      | 019519-398          | 2561             |
| 7590   | 10/14/2004  |                      |                     | EXAMINER         |
| BURNS, DOANE, SWECKER & MATHIS, L.L.P.<br>P.O. Box 1404<br>Alexandria, VA 22313-1404 |             |                      | LE, HOA VAN         |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1752                |                  |

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                  |
|------------------------------|-----------------|------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)     |
|                              | 10/621,360      | YOSHIDA, KAZUAKI |
|                              | Examiner        | Art Unit         |
|                              | Hoa V. Le       | 1752             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-5 is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 6-12 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>27 September 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

This is in response to Papers filed 27 September 2004.

I. Applicant's partial English language translation of Japanese Patent No. 11-288068 has been considered.

II. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, conditional, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language "pH is from...", "specific gravity is..." or the like is considered as a property of a material and searched as appeared.

B. In re Schreiber, 44 USPQ2d 1429 states that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk".

III. The following is an examiner's statement of reasons for allowance:

(1) It is known in the art to make and obtain to a two part kit of the separate bleach and fix concentrate solutions for making a combined bleach and fix function composition to avoid

chemical interaction and stable product on a storage. Evidence can be seen in at least (Nakazyo et al (4,956,268) and Kawai (5,565,310) as submitted Yoshida (5,391,467) and Abstract of DE 4402916. Patentees fail to cite pH value and/or specific gravity property of a material as claimed.

(2) Patentee in Japanese Patent No. 411288068 discloses a specific gravity of a bleach function solution but fail to cite pH value or a two-part kit as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

IV. This application is in condition for allowance except for the following formal matters:

The non-elected invention of Group II is related to process of using claims 6-12 with an undirected or unrelated (\*) single and (\*\*) diluted bleach and fix function mixture of "1" and "2" solution. The record shows that it has been considered or searched. Applicant should show or provide convincing evidence to the contrary.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

V. Applicant's arguments filed 27 September 2004 have been fully considered but they are not persuasive.

Applicant urges that since the elected invention of Group I is related to a kit having two separate parts "1)" and "2)" bleach and fix concentrate solutions of material claims 1-5, the undirected and unrelated (\*) single and (\*\*) diluted bleach and fix function mixture of "1)" and "2)" solution in the non-elected invention of Group II, process of use claims 6-12, should be rejoined with the allowable material claims 1-5 because the process claims are depended on the allowable material claims.

The requests and arguments are not found to be convincing because:

- (A) The non-elected invention of Group II is related to process of using claims 6-12 with an undirected or unrelated (\*) single and (\*\*) diluted bleach and fix function mixture of "1)" and "2)" solution. Applicant should show or provide convincing evidence to the contrary in order for the requests and arguments to have some merits.
- (B) The record shows that none of the patentable issues in a single and diluted bleach and fix function mixture of "1)" and "2)" solution is considered or searched.
- (C) The record also shows that the elected invention of Group I, material claims 1-5 are considered and searched on two separate parts in a kit only. Applicant should show or provide convincing evidence to the contrary in order for the requests and arguments to have some merits.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
12 October 2004

HOA VAN LE  
PRIMARY EXAMINER

*Hoa Van Le*